

Attorney Docket No.: 47234-0003-00US
Application No. 10/500,841
Reply to Office Action Dated: February 19, 2008
Amendment and Reply Dated: April 8, 2008

REMARKS

Restriction Requirement

The Office alleges that newly added claims 25-30 introduce two patently independent and distinct polypeptides, namely the polypeptides of (a) SEQ ID NO: 7 and (b) SEQ ID NO: 11. The Office Action inadvertently refers to the claims as directed to nucleic acid molecules encoding the polypeptides. Applicants request appropriate clarification in the next communication from the Office. Applicants elect the polypeptide of **SEQ ID NO: 7 with traverse**. The claims reading on the elected invention are claims 6-7, 23-27 and 29-30.

The Office alleges that the polypeptides and species (a) and (b) above lack unity of invention, because a β -1,6-N-acetylglucosaminyltransferase comprising SEQ ID NO: 7 and SEQ ID NO: 11 is allegedly known in the art. Applicants traverse the restriction requirement on the following grounds:

1. The Burden of Search Is Not Undue

First, unity was found in the corresponding PCT application. When unity is found in the PCT application, there is an *increased burden* above the already “*serious burden*” in evincing why a restriction requirement is necessary. *See* Anthony Caputa, “Two Be or Not To Be: or Divide and Conquer: or A Case Divided Cannot Stand: Principles in Restriction Practice TC 1600,” presented August 2004 to the Customer Partnership Meeting.

The Office fails to address the burden of search in the restriction requirement. *See* M.P.E.P. §§ 803.02, 806.04(a), 806.04(i), 808.01(a) and 808.02; *see also* T. Caputa. Additionally, as stated by Examiner Caputa, “If the inventions, now being restricted, were searched and examined together in either the current application or a parent, it will be difficult to justify the assertion of burden.” T. Caputa, at page 6. The Office fails to address burden, let alone justify the restriction requirement in view of the burden of search. The restriction accordingly should be duly reconsidered and withdrawn.

In this regard, the new claims recite subject matter that was encompassed by the original claims, which have already been searched and examined in this application. The search of the claims reciting SEQ ID NO: 7 and SEQ ID NO: 11 *already has been carried out* and cannot constitute an undue burden to the Office at this point.

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In addition, the polypeptide sequences of SEQ ID NO: 7 and SEQ ID NO: 11 *overlap*.

This is shown in the diagram below:

MALFTPWKLSSQKLGFFLVTFGFIWGMMLLHFTIQQRTQPSSSMLREQILDLSKRYI
 KALAEENRNVVDGPYAGVMTAYDLKKTLAVLLDNILQRIGKLESKVDNLVVNGTG
 TNSTNSTTAVPSLVALEKINVADIINGAQEKCVLPMDGYPHCEGKIKWMKDMWRS
 DPCYADYGVDGSTCSFFIYLSEVENWCPHLPWRAKNPYEEADHNSLAEIRTDNFILY
 SMMKKHEEFRWMRLRIRRMADAWIQAIKSLAEKQNLKRRKKVLVHLGLLTKE
 GFKIAETAFSGGPLGELVQWSDLITSLYLLGHDIRISASLAEELKEIMKKVVGNRSGCPT
 VGDRIVELIYIDIVGLAQFKKTLGPSWVHYQCMLRVLDSEFGTEPEFNHANYAQSKGH
 KTPWGKWNLNPPQFYTMFPHTPDNSFLGFVVEQHLNSSDIHHINEIKRQNSLVYGK
 VDSFWKNKKIYLDIIHTYMEVHATVYGSSTKNIPSYVKNHGILSGRDLQFLRETCLF
 VGLGFPYEGPAPLEAANGCAFLNPKFNPPKSSKNTDFFIGKPTLRELTSQHPYAEVFI
 GRPHVWTVDLNNQEEVEDAVKAILNQKIEPYMPYEFTCEGMLQRINAFIEKQDFCHG
 QVMWPPLSALQVKLAEPG [SEQ ID NO: 6]

Double-Underlined sequence = SEQ ID NO: 11 and overlapping sequences of SEQ ID NO: 7

Underlined sequence = SEQ ID NO: 7

Restriction is improper when the subject matter of species overlaps in scope. *See* MPEP § 804.04(f). For this reason alone, it is improper and should be withdrawn.

2. The PCT Does Not Contemplate Species Elections

Second, PCT practice does not permit species elections, where the species are “of a similar nature.” *See* MPEP § 1850(III)(B), “Markush Practice.” The polypeptide sequences are similar in nature within the meaning of PCT rules, at least because their sequences overlap. *See* MPEP §1850(III)(B)/(A) or (B)(1). Treaty provisions under the Patent Cooperation Treaty trump those of the U.S. Patent and Trademark Office under a conflict of laws analysis. *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 U.S.P.Q. 590 (E.D. Va. 1986). Under Article 27 of the PCT, “No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and Regulations.” *Caterpillar Tractor*, 231 U.S.P.Q. at 590-591. By instituting a species election despite the species being similar in nature, the Office is instituting an illegal requirement that is different from and in addition to the requirements set forth by the PCT. Accordingly, Applicants request that the species election be withdrawn and the claims considered in their entirety.

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3. The Subject Matter of the Two Species Is Novel Over the Cited Art

Finally, the Office alleges, *without providing evidence*, that the two recited polypeptide sequences are disclosed in the prior art. Specifically, the Office alleges that a β 1,6-N-acetylglucosaminyltransferase comprising SEQ ID NO: 7 and SEQ ID NO: 11 is allegedly known in the art. Applicants already have distinguished the claims from the references cited previously in support of the allegation that the claims lack novelty. *See, e.g.*, Amendment and Response Filed Under 37 C.F.R. § 1.114, which is incorporated herein in its entirety. The claims do not lack novelty over the cited art. The claims thus possess a special technical feature that unites the claims. Because the claims possess unity of invention, the present requirement is improper and should be withdrawn.

CONCLUSION

Should the Examiner have any questions or comments regarding Applicants' amendments or response, he is asked to contact Applicants' undersigned representative at the telephone number below. Please direct all correspondence to the below-listed address.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0573. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is respectfully requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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